

PATENT
Application # 10/064,251
Attorney Docket # 2001-0337 (1014-284)

REMARKS

The Examiner is respectfully thanked for the consideration provided to this application. Reconsideration of this application is respectfully requested in light of the foregoing amendments and the following remarks.

Each of claims 1, 6, and 10 has been amended for at least one reason unrelated to patentability, including at least one of: to explicitly present one or more elements, phrases, and/or words implicit in the claim as originally written when viewed in light of the specification, thereby not narrowing the scope of the claim; to detect infringement more easily; to enlarge the scope of infringement; to cover different kinds of infringement (direct, indirect, contributory, induced, and/or importation, etc.); to expedite the issuance of a claim of particular current licensing interest; to target the claim to a party currently interested in licensing certain embodiments; to enlarge the royalty base of the claim; to cover a particular product or person in the marketplace; and/or to target the claim to a particular industry.

Each of claims 14-20 has been added.

Support for the amendments to claims 6 and 10 can be found in the specification as originally filed at least at paragraph 0048. Support for new claims 14-20 can be found paragraphs 0022, 0025, 0038, and 0042. It is respectfully submitted that no new matter has been introduced.

Claims 1-20 are now pending in this application. Each of claims 1, 6, and 10 are in independent form.

I. The Anticipation Rejections

Claim 1 was rejected as anticipated under 35 U.S.C. 102(e). In support of the rejection, various portions of U.S. Patent No. 6,725,401 ("Lindhorst-Ko") were applied. These rejections are respectfully traversed.

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A. The Legal Standards

1. Express Anticipation

To establish a *prima facie* case of express anticipation, the “invention must have been known to the art in the detail of the claim; that is, all of the elements and limitations of the claim must be shown in a single prior art reference, arranged as in the claim”. *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1383, 58 USPQ2d 1286, 1291 (Fed. Cir. 2001); *See also*, MPEP 2131. The single reference must describe the claimed subject matter “with sufficient clarity and detail to establish that the subject matter existed in the prior art and that its existence was recognized by persons of ordinary skill in the field of the invention”. *Crown Operations Int'l, LTD v. Solutia Inc.*, 289 F.3d 1367, 1375, 62 USPQ2d 1917, 1921 (Fed. Cir. 2002). Moreover, the prior art reference must be sufficient to enable one with ordinary skill in the art to practice the claimed invention. *In re Borst*, 345 F.2d 851, 855, 145 USPQ 554, 557 (CCPA 1965), *cert. denied*, 382 U.S. 973 (1966); *Amgen, Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1354, 65 USPQ2d 1385, 1416 (Fed. Cir. 2003) (“A claimed invention cannot be anticipated by a prior art reference if the allegedly anticipatory disclosures cited as prior art are not enabled.”)

The USPTO “has the initial duty of supplying the factual basis for its rejection.” *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (CCPA 1967).

2. Inherent Anticipation

Establishing *prima facie* case of “[i]nherent anticipation requires that the missing descriptive material is necessarily present, not merely probably or possibly present, in the prior art.” *Trintec Indus., Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1295, 63 USPQ2d 1597, 1599 (Fed. Cir. 2002); *See also*, MPEP 2112.

B. Analysis

Lindhorst-Ko fails to establish a *prima facie* case of anticipation.

Specifically, claim 1 states, *inter alia*, yet the applied portions of Lindhorst-Ko do not teach, “computing a service path and a restoration path; and (iii) sending a label switched path

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request along the restoration path requesting reservation of shared resources along the restoration path without allocating the shared resources and wherein the label switched path request includes service path information". Claim 1 distinguishes "a service path" from "a restoration path". The applied portions of Lindhorst-Ko do not teach sending "service path information" "along the restoration path". Instead, the applied portion of Lindhorst-Ko at most discloses sending service path information along the service path.

Moreover, the present Office Action alleges, at Pages 2-3:

Note that as the LSP path setup message is propagated in Lindhorst-Ko system without allocating any resources and inherently has to contain some level path information as it is after all a path setup message. Each node in the path allocates resources after receiving the path setup message and informs the source node via resource allocation message.

Yet the present Office Action fails to establish a case of inherent anticipation since no evidence has been presented that the admittedly "missing descriptive material is 'necessarily present'" in Lindhorst-Ko. Thus, the present Office Action fails to properly establish inherent anticipation.

For at least this reason, it is respectfully submitted that the rejection of claim 1 is unsupported by Lindhorst-Ko and should be withdrawn.

II. The Obviousness Rejections

Each of claims 2-13 was rejected under 35 U.S.C. 103(a) as being unpatentable over various combinations of U.S. Patent No. 6,725,401 ("Lindhorst-Ko"), "Constraint-Based LSP Setup Message Reversing of CR-LDP" ("Kim"), U.S. Patent No. 6,882,627 ("Pieda"), U.S. Patent No. 6,044,064 ("Brimmage"), U.S. Patent No. 6,542,934 ("Bader"), and/or U.S. Patent No. 7,099,327 ("Nagarajan"). Each of these rejections is respectfully traversed.

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A. Legal Standards

1. *Prima Facie* Criteria for an Obviousness Rejection

Over 50 years ago, in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), the Supreme Court established factors regarding the factual inquiry required to establish obviousness. The factors include:

1. determining the scope and contents of the prior art;
2. ascertaining differences between the prior art and the claims at issue;
3. resolving the level of ordinary skill in the pertinent art; and
4. considering objective evidence indicating obviousness or nonobviousness.

The Federal Circuit has applied *Graham*'s required factual inquiry in numerous legal precedents that are binding on the USPTO.

It is recognized that most patentable inventions arise from a combination of old elements and often, each element is found in the prior art. *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998). However, mere identification in the prior art of each element is insufficient to defeat the patentability of the combined subject matter as a whole. *Id.* at 1355, 1357.

Instead, “[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach... all the claim limitations.” *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP 2143.

Moreover, the “Patent Office has the initial duty of supplying the factual basis for its rejection.” *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057, *reh'g denied*, 390 U.S. 1000 (1968). “It may not... resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis”. *Id.*

It is legal error to “substitute[] supposed *per se* rules for the particularized inquiry required by section 103. It necessarily produces erroneous results.” *See, In re Ochiai*, 71 F.3d 1565, 1571, 37 USPQ2d 1127, 1132-33 (Fed. Cir. 1998); *In re Wright*, 343 F.2d 761, 769-770, 145 USPQ 182, 190 (CCPA 1965).

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“Once the examiner... carries the burden of making out a *prima facie* case of unpatentability, ‘the burden of coming forward with evidence or argument shifts to the applicant.’” *In re Alton*, 76 F.3d 1168, 37 USPQ2d 1578 (Fed. Cir. 1996) (*quoting In re Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444).

2. Next Office Action

If an Office Action fails to set forth sufficient facts to provide a *prima facie* basis for the rejections, any future rejection based on the applied reference will necessarily be factually based on an entirely different portion of that reference, and thus will be legally defined as a “new grounds of rejection.” Consequently, any Office Action containing such rejection can not properly be made final. *See, In re Wiechert*, 152 USPQ 247, 251-52 (CCPA 1967) (defining “new ground of rejection” and requiring that “when a rejection is factually based on an entirely different portion of an existing reference the appellant should be afforded an opportunity to make a showing of unobviousness vis-a-vis such portion of the reference”), and *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (CCPA 1967) (the USPTO “has the initial duty of supplying the factual basis for its rejection”).

B. Analysis

1. Claim 2

a. *Prima Facie* Criteria

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establish a *prima facie* case of obviousness. Since claim 2 depends from claim 1, Applicant respectfully incorporates by reference each traversal, *supra*, regarding the rejection of claim 1.

b. Missing Claim Limitations

Claim 2 states, *inter alia*, yet the applied portions of Kim do not teach, “wherein the service path information comprises a list of links used along the service path”. Applicant respectfully submits that, when read in light of claim 1, claim 2 requires that the “list of links

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used along the service path" must be sent along "the restoration path". Kim does not teach sending a "list of links used along the service path" along "the restoration path".

The applied portions of Lindhorst-Ko fail to cure at least these deficiencies of the applied portions of Kim.

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as **attempted to be modified and/or combined**, still do not expressly or inherently teach every limitation of the independent claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

c. Conclusion

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 2 is respectfully requested.

2. Claim 3

a. *Prima Facie* Criteria

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establish a *prima facie* case of obviousness. Since claim 3 depends from claim 1, Applicant respectfully incorporates by reference each traversal, *supra*, regarding the rejection of claim 1.

b. Missing Claim Limitations

Claim 3 states, *inter alia*, yet the applied portions of Kim do not teach, "wherein the service path information comprises a list of shared risk link groups traversed by the service path". Applicant respectfully submits that, when read in light of claim 1; claim 3 requires that

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the "list of shared risk link groups traversed by the service path" must be sent along "the restoration path". Kim does not teach sending a "list of shared risk link groups traversed by the service path" along "the restoration path".

The applied portions of Lindhorst-Ko fail to cure at least these deficiencies of the applied portions of Kim.

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as **attempted to be modified and/or combined**, still do not expressly or inherently teach **every** limitation of the independent claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

c. Conclusion

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 3 is respectfully requested.

3. Claim 4

a. *Prima Facie* Criteria

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establish a *prima facie* case of obviousness. Since claim 4 depends from claim 1, Applicant respectfully incorporates by reference each traversal, *supra*, regarding the rejection of claim 1.

b. Conclusion

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 4 is respectfully requested.

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4. Claim 5

a. *Prima Facie* Criteria

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establish a *prima facie* case of obviousness. Since claim 5 depends from claim 1, Applicant respectfully incorporates by reference each traversal, *supra*, regarding the rejection of claim 1.

b. Conclusion

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 5 is respectfully requested.

5. Claims 6-9

Applicant respectfully submits that the rejections of claims 6-9 are moot in light of the amendments to claim 6. Specifically, claim 6, upon which each of claims 7-9 depends, states, yet none of the applied portions of the relied upon references teach, "the second message comprising an object that comprises a code, a first possible value of the code indicative that bridging has been completed, a second possible value of the code indicative that a roll/bridge has been completed, a third possible value of the code indicative that a roll has been completed."

6. Claims 10-13

Applicant respectfully submits that the rejections of claims 10-13 are moot in light of the amendments to claim 10. Specifically, claim 10, upon which each of claims 11-13 depends, states, yet none of the applied portions of the relied upon references teach, "the second message comprising an object that comprises a code, a first possible value of the code indicative that bridging has been completed, a second possible value of the code indicative that a roll/bridge has been completed, a third possible value of the code indicative that a roll has been completed."

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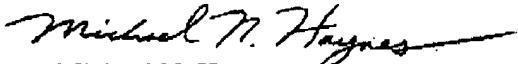
CONCLUSION

It is respectfully submitted that, in view of the foregoing amendments and remarks, the application as amended is in clear condition for allowance. Reconsideration, withdrawal of all grounds of rejection, and issuance of a Notice of Allowance are earnestly solicited.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. 1.16 or 1.17 to Deposit Account No. 50-2504. The Examiner is invited to contact the undersigned at 434-972-9988 to discuss any matter regarding this application.

Respectfully submitted,

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